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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/530,345	04/06/2005	Kiyohito Shigemura	2005_0581A	7764

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EXAMINER	
DICUS, TAMRA	

ART UNIT	PAPER NUMBER
1774	

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07/13/2007	PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/530,345	<b>Applicant(s)</b> SHIGEMURA, KIYOHITO	
	<b>Examiner</b> Tamra L. Dicus	<b>Art Unit</b> 1774	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☐ Responsive to communication(s) filed on 4/6/05
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 10-18 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 10-18 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)  | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date <u>4-6-05</u> | 6) <input type="checkbox"/> Other: _____  |

**DETAILED ACTION*****Drawings***

The drawings are objected to as failing to comply with 37 CFR 1.84(p)(4) because reference character "113" has been used to designate two different elements. Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Figures 4-6 and 10-13 should be designated by a legend such as --Prior Art-- because only that which is old is illustrated. See MPEP § 608.02(g). Corrected drawings in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. The replacement sheet(s) should be labeled "Replacement Sheet" in the page header (as per 37 CFR 1.84(c)) so as not to obstruct any portion of the drawing figures. If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 10-11, and 13-18 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 10-18 are not clear because “belt-shaped pattern” is not a clear term as there is nothing in the specification to explain what this means. It is not clear if it’s a rectangular shape, or a strip shape or a strip with holes or apertures in it or an image or embossing of a belt. It’s not clear as to what is intended by this term.

Claims 10-11, 13-18 are not clear to the adhesive layer overlapping the release layer, “overlaps” usually implies actually surfaces touching, which would mean there can’t exist inner layers between the overlapping ones when the layers are laminated wholly/completely/all over the underlying layer (mold release layer). Thus, the overall structure is not clear.

Claim 15 recites the limitation “the resin board”. There is insufficient antecedent basis for this limitation in the claim.

Claim 15 is not clear because it recites a peel strength property without referencing at what interface this is a property of.

*Claim Rejections - 35 USC § 102*

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 10-18 are rejected under 35 U.S.C. 102(e) as being anticipated by Applicant's own admissions.

Because Applicant has identified Figs. 4-6 and 10-13 as conventionally known products and processes (see Brief Description of Drawings starting on page 9), they are prior to Applicant's filing date. Instant Figs. 4-6 and 10-13 disclose all the elements, materials, and inherent properties of instant claims 10-18. For example, see instant claims 10 and 15 disclosing: a transfer member (101, Fig. 4 and associated text) comprising: a substrate sheet (102, Fig. 4 and associated text); a mold release layer of a belt-shaped pattern (103, Fig. 4 and associated text) laminated on the substrate sheet; an ionizing radiation curing layer (109, Fig. 4 and associated text) laminated all over a surface on the mold release layer; a patterned layer (105, Fig. 4 and associated text) laminated all over a surface or partially on the ionizing radiation curing layer; and an adhesive layer (106, Fig. 4 and associated text) laminated on the patterned layer, so as not to locate at a region where the mold release layer is not formed, only partially in a portion where the adhesive layer overlaps with the mold release layer, wherein the substrate

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sheet inherently has a peel strength smaller than 50 N/m because the same material is employed.

To instant claim 15, what happens when the transfer member is peeled off at a 90 degree angle is a process limitation, given little weight. Product-by-process claims are not limited to the manipulations of the recited steps, only the structure implied by the steps. Patentability of an article depends on the article itself and not the method used to produce it (see MPEP 2113).

Furthermore, the invention defined by a product-by-process invention is a product NOT a process. *In re Bridgeford*, 357 F. 2d 679. It is the patentability of the product claimed and NOT of the recited process steps which must be established. *In re Brown*, 459 F. 2d 531. Both Applicant's and prior art reference's product are the same.

Claims 10 and 15 are rejected under 35 U.S.C. 102(b) as being anticipated by JP 11-058584 (Nakamura).

For purposes of examination, the Examiner interprets the claims as the following:

Nakamura teaches per instant claim 10 a transfer member comprising: a substrate sheet (1, Drawing 1 and associated text); a mold release layer of a belt-shaped pattern (2, Drawing 1 and associated text, rectangular shape shown in drawing) laminated on the substrate sheet; an ionizing radiation curing layer (3, Drawing 1 and associated text) laminated all over a surface on the mold release layer; a patterned layer (4, Drawing 1 and associated text) laminated all over a surface or partially on the ionizing radiation curing layer; and an adhesive layer (5, Drawing 1 and associated text) laminated on the patterned layer, so as not to locate at a region where the mold release layer is not formed, only partially in a portion where the adhesive layer overlaps with the mold release layer. See also 0013-0015, Abstract. Claims 10<sup>and</sup> 15 are met. Further to

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claim 15, the substrate of 'Nakamura is made of cellulose, polymeric resin films, or metal foils ([0010]) is the same of Applicant disclosed on page 13, lines 1-5, cellulose and metal foils and a silicone release (same as page 15 of instant specification) . Therefore, the material and structure of Nakamura inherently has a peel strength property as claimed. A chemical composition and its properties (peel) are inseparable. Therefore, if the prior art teaches the identical chemical structure, the properties applicant discloses and/or claims are necessarily present. *In re Spada*, 911 F.2d 705, 709, 15 USPQ2d 1655, 1658 (Fed. Cir. 1990). To instant claim 15, what happens when the transfer member is peeled off at a 90 degree angle is a process limitation, given little weight. Product-by-process claims are not limited to the manipulations of the recited steps, only the structure implied by the steps. Patentability of an article depends on the article itself and not the method used to produce it (see MPEP 2113). Furthermore, the invention defined by a product-by-process invention is a product NOT a process. *In re Bridgeford*, 357 F. 2d 679. It is the patentability of the product claimed and NOT of the recited process steps which must be established. *In re Brown*, 459 F. 2d 531. Both Applicant's and prior art reference's product are the same.

Claims 10-18 are rejected under 35 U.S.C. 102(b) as being anticipated by Kosaka et al.

For purposes of examination, the Examiner interprets the claims as the following: Kosaka teaches per instant claim 10 a transfer member comprising: a substrate sheet (base film 11, FIG. 21 and associated text); a mold release layer of a belt-shaped pattern (release layer and mask 18, FIG. 21 and associated text, release is used between each layer stacked on 11, 29:55-68, thereby contouring or indentations are present at the interface of the release and mask, further

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functioning as an “anchor layer”) laminated on the substrate sheet; an ionizing radiation curing layer (12d or 12 c, barrier and dielectric layers, the dielectric, electrode, and barrier forming layers formed of ionizing curable resins like that in the electrode-forming and first sheet (25:15-45, 23:23-40, 15:45-60), FIG. 21 and associated text) laminated all over a surface on the mold release layer; a patterned layer (electrode-forming 12b, FIG. 21 and associated text) laminated all over a surface or partially on the ionizing radiation curing layer; and an adhesive layer (disposed between primer 12a and protective layer 13 (functioning as nonadhesive as it's protective, not of adhesive material and does not overlap with mold release because it's not adjacent to it), referring to the thirteenth transfer sheet as FIG. 21 (29:32-65) laminated on the patterned layer, so as not to locate at a region where the mold release layer is not formed, only partially in a portion where the adhesive layer overlaps with the mold release layer Claims 10-18 are met. Further to claim 15, the substrate of Kosaka is made of cellulose, polymeric resin films, or metal foils (9:30-55), the same of Applicant disclosed on page 13, lines 1-5, cellulose and metal foils and a release (same as page 15 of instant specification). Therefore, the material and structure of Kosaka inherently has a peel strength property as claimed. A chemical composition and its properties (peel) are inseparable. Therefore, if the prior art teaches the identical chemical structure, the properties applicant discloses and/or claims are necessarily present. *In re Spada*, 911 F.2d 705, 709, 15 USPQ2d 1655, 1658 (Fed. Cir. 1990). To instant claim 15, what happens when the transfer member is peeled off at a 90 degree angle is a process limitation, given little weight. Product-by-process claims are not limited to the manipulations of the recited steps, only the structure implied by the steps. Patentability of an article depends on the article itself and not the method used to produce it (see MPEP 2113). Furthermore, the invention defined by a



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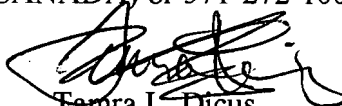
product-by-process invention is a product NOT a process. *In re Bridgeford*, 357 F. 2d 679. It is the patentability of the product claimed and NOT of the recited process steps which must be established. *In re Brown*, 459 F. 2d 531. Both Applicant's and prior art reference's product are the same.

### ***Conclusion***


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Tamra L. Dicus whose telephone number is 571-272-1519. The examiner can normally be reached on Monday-Friday, 7:00-4:30 p.m., alternate Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Milton Cano can be reached on 571-272-3186. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

  
Tamra L. Dicus  
Examiner  
Art Unit 1774

June 22, 2007

  
MILTON I. CANO  
SUPERVISORY PATENT EXAMINER